

REMARKS

Status of Claims / Summary of the Amendment

Claims 54-56 and 63-70 are currently pending. The rejections of the claims and reasons why Applicant believes that all of the pending claims are currently in condition for allowance are discussed below.

Rejections Under 35 U.S.C. § 101

Claims 54-56 and 63-70 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 66 was rejected as being directed to non-statutory subject matter because “capable of storing” does not mean that the computer-readable instructions are stored in a computer-readable storage medium. Claim 66 has been amended to recite “a computer-readable storage medium having computer-executable instructions stored thereon.”

Therefore, Applicant believes that the rejection to Claim 66 under 35 U.S.C. § 101 has been overcome. Accordingly, Applicant requests reconsideration and withdrawal of the rejection

The Office Action further states that “Claim 66 includes a 101 judicial exception.” The Office Action does not provide any further explanation as to this alleged “judicial exception.” Applicant cannot be expected to respond to such a vague and rejection. If it is still contended that Claim 66 is directed to non-statutory subject matter, then a non-final rejection that clearly states the rejection should be presented such that the Applicant has an opportunity to respond to this new, unclear, non-supported rejection.

With respect to apparatus Claim 54, the Office Action states that “Claim 54 applies a computer program as part of a seemingly patentable apparatus, however, claim 54 in reality seeks patent protection for the computer program as evidenced by Claim 66 in the abstract. Computer program per se is neither computer components nor statutory process. Thus, claim 54 is non-statutory.”

Applicant and Applicant's representative were unable to ascertain the actual reason for rejection of these claims. On July 12, 2007, Applicant's representative, Marlene Klein, telephoned the Examiner and requested an explanation for this rejection. The Examiner stated that this meant that there was no tangible result. Applicant's representative stated that determining whether a printed document was an original or a copy is a tangible result. The Examiner stated that "determining" is a calculation, i.e., a step performed by a computer and therefore cannot produce a tangible result. However, the Examiner was not able to provide any further support for his contention. Applicant respectfully requests that if such a rejection is maintained that the Examiner and his supervisor set up an interview with Examiner's representative to provide support for such a rejection.

Apparatus Claims 55-56 and 67-68 and method Claims 63-65 and 69-70 were rejected on the same bases as Claim 54. For the reasons stated above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 101 of these claims as well. As noted above, if the Examiner wishes to maintain these rejections, Applicant requests an interview with the Examiner and Examiner's supervisor in order to advance the prosecution of the application.

Rejections Under 35 U.S.C. § 102

Claims 54-56 and 63-70 were rejected under 35 U.S.C. § 102(e) as being anticipated by Shimada et al. (U.S. Published Patent Application 2004-0021311) (hereinafter "Shimada et al."). Claims 54-56 and 63-70 were also rejected under 35 U.S.C. § 102(e) as being anticipated by Matsunoshita (U.S. Published Patent Application 2003-0179412) (hereinafter "Matsunoshita").

The Claims Are Not Anticipated by the Shimada et al. Reference

The Office Action states that the Shimada et al. reference discloses "latent-image portion, background area-latent-image peripheral portion and additional information including the authenticity discrimination pattern-9 or wave pattern, moiré pattern, emboss pattern, etc. of Paragraph 0103)." Office Action Pages 10-11. The "additional

information” disclosed in the Shimada et al. reference is not “additional information” as required by the claims. This information is information that defines the image pattern, e.g., see Fig. 12 of the Shimada et al. reference.

Claim 54 includes a feature that “it can be determined whether an image on a printed material is an original because the additional information can be extracted from the original image based on the positions of the arranged second dots and predetermined positions in the latent-image area, and the additional information cannot be extracted from a copy.” Clearly, what is alleged as being “additional information” in the Office Action (definition of image pattern, such as wave or moiré) is not the same as the “additional information” in Claim 54. Furthermore, Claim 54 has been amended to include “information-attaching means for attaching the additional information to at least the latent image area” to further clarify this feature.

In addition, the Office Action states that according to MPEP 2111.04 “adapted to,” “adapted for,” “wherein,” and “whereby” clauses do not limit claim scope. Applicant has amended the claims as requested by the Examiner to remove the “wherein” clauses. However, it should be noted that the interpretation of this section in the Office Action does not accurately reflect MPEP 2111.04 which states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "'whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.'" *Id.* (emphasis added)

The Shimada et al. reference does not teach or suggest, *inter alia*, “inputting means for inputting area-assignment information that defines latent-image area and background area and additional information” or “information-attaching means for attaching the additional information to at least the latent image area so that it can be determined whether an image on a printed material is an original because the additional information can be extracted from the original image based on the positions of the arranged second dots and predetermined positions in the latent-image area, and the additional information cannot be extracted from a copy” as required by Claim 54.

Accordingly, Claim 54 is believed allowable over the Shimada et al. reference.

Because independent Claim 54 is believed allowable, all of the claims depending therefrom (Claims 55, 56, 67 and 68) are also allowable for at least the same reasons as discussed above with reference to Claim 54. Furthermore, each dependent claim is also deemed to define an additional aspect of the invention, and individual consideration of each on its own merits is respectfully requested.

With respect to the dependent claims (Claims 55, 56, 67 and 68), Applicant cannot find the language that the Examiner is finding in the Shimada et al. reference that the Examiner believes provides support for rejection of the dependent Claims. Applicant requests that the Examiner more specifically point that the language that allegedly teaches the limitations of the dependent claims.

Claims 63 and 66 were rejected on the same bases as Claim 54. Claims 63 and 66 are believed allowable for at least the same reasons as Claim 54.

Because independent Claim 63 is believed allowable, Claims 64, 65, 69 and 70 which depend from Claim 63 are also believed allowable for at least the same reasons as Claim 63 (which is believed allowable for the same reasons as Claim 54). Furthermore, each dependent claim is also deemed to define an additional aspect of the invention, and individual consideration of each on its own merits is respectfully requested as discussed above with reference to Claims 55, 56, 67 and 68.

As described above, the Shimada et al. reference does not anticipate any of the claims.

The Claims Are Not Anticipated by the Matsunoshita Reference

The Office Action dated October 30, 2006 stated that the Matsunoshita reference is silent as to the claim limitation “wherein the additional information can be extracted based on the difference between the positions of the arranged dots and predetermined positions.” Now, the Office Action dated April 16, 2007 alleges that the Matsunoshita reference discloses “wherein it can be determined whether an image on a printed material is an original because the additional information can be extracted from the original image based on the positions of the arranged second dots and predetermined positions in the latent-image area, and the additional information cannot be extracted from a copy.”

The Office Action cites paragraphs 0147-0148 and 0161-0163 as support for this assertion. Applicant could not find support for this in the cited portions or elsewhere in the Matsunoshita reference.

Applicant’s representative asked the Examiner about this and the Examiner’s response was “the claim was amended.” While it is true that the claim, including this limitation was amended, the claim limitation still includes the limitation previously noted as not being in the Matsunoshita reference. If such a teaching is there, it is not apparent based on the description in the Office Action or the portions of the Matsunoshita reference cited in the Office Action. Applicant cannot find the language that the Examiner is finding in the Matsunoshita reference that teaches, *inter alia*, “wherein, it can be determined whether an image on a printed material is an original because the additional information can be extracted from the original image based on the positions of the arranged second dots and predetermined positions in the latent-image area, and the additional information cannot be extracted from a copy” as required by Claim 54. If such a rejection is maintained, Applicant respectfully requests that the language in the cited reference that allegedly teaches this be specifically pointed out.

Because the Matsunoshita reference does not teach or suggest all of the limitation of Claim, Claim 54 is believed allowable over the Matsunoshita reference.

Because independent Claim 54 is believed allowable, all of the claims depending therefrom (Claims 55, 56, 67 and 68) are also allowable for at least the same reasons as discussed above with reference to Claim 54. Furthermore, each dependent claim is also

deemed to define an additional aspect of the invention, and individual consideration of each on its own merits is respectfully requested.

Claims 63 and 66 were rejected on the same bases as Claim 54. Claims 63 and 66 are believed allowable for at least the same reasons as Claim 54.

Because independent Claim 63 is believed allowable, Claims 64, 65, 69 and 70 which depend from Claim 63 are also believed allowable for at least the same reasons as Claim 63 (which is believed allowable for the same reasons as Claim 54). Furthermore, each dependent claim is also deemed to define an additional aspect of the invention, and individual consideration of each on its own merits is respectfully requested as discussed above with reference to Claims 55, 56, 67 and 68.

As described above, the Matsunoshita reference does not anticipate any of the claims.

Neither of the cited and applied references, namely, Shimada et al. and Matsunoshita, either alone or in combination, teach or suggest all of the claim limitations. Accordingly, all of the claims are believed allowable.

As noted above, there are several new rejections that are not clear and/or are not supported. As noted above, Applicant respectfully requests that if such rejections are maintained that adequate support be provided as noted above with respect to the individual rejections. Alternatively, or additionally, Applicant respectfully requests an interview with the Examiner and the Examiner's supervisor.

CONCLUSION

Applicant respectfully submits that all of the claims pending in the application meet the requirements for patentability and respectfully requests that the Examiner indicate the allowance of such claims.

Any amendments to the claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If any additional fee is required, please charge Deposit Account Number 502456.

Should the Examiner have any questions, the Examiner may contact Applicant's representative at the telephone number below.

Respectfully submitted,

July 13, 2007

/Marlene Klein/

Date

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